

Patent Application S/N: 09/182,842

Attorney Docket No.: P-2195

REMARKS

Claims 1, 3-11, and 13-18 are pending and stand rejected and are therefore at issue.

Support for the Amendment

Claim 1 is amended to recite that the "carrier [is] slidably and removably mountable in the docking assembly." In addition, specific limitation as to which parts define the plural PC card slots is removed. This language is supported at least by Claim 1 as originally filed and by Figure 2 and accompanying text in the Specification. This amendment does not narrow Claim 1 since the carrier was understood to be removable in Claim 1 as originally filed and removing limitations regarding the definition of the plural PC card slots actually broadens Claim 1.

Claim 15 is amended to avoid the need for antecedent basis and to avoid recitation of "offset" which has been objected to by the Examiner. The amendments to Claim 15 do not narrow Claim 15.

No new matter is added.

The Claims are Allowable Over the Cited Art

The Examiner rejected all pending claims under 35 USC 103(a) as being unpatentable over Pollard et al. (U.S. Patent 5,171,183) in view of Darden et al. (U.S. Patent 4,941,841), Uwabo et al. (U.S. Patent 5,583,745), and Iwasaki et al. (U.S. Patent 6,137,710). Applicant respectfully traverses this rejection and requests reconsideration and withdrawal of this rejection.

To facilitate discussion, Applicant will summarize the Examiner's rejection of Claim 1 as Applicant understands it. At the time the invention was made, the ordinary artisan would begin

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with the mounting bracket with fan of Pollard et al. and replace Pollard's floppy drive 10 with either the device of Uwabo et al. or the device of Iwasaki et al. Next, the ordinary artisan would mount the mounting bracket and the device together inside the slide-in cartridge 40 of Darden et al.

This combination is troubling for a few reasons. One reason is that the specific teachings of the references make such a combination impractical. In particular, Darden et al. teach that their mounting bracket 100 fits in a standard 5½-inch drive bay while Pollard et al. also teach that their bracket 20 fits in a standard 5½-inch drive bay. Thus, the outside dimensions of bracket 20 of Pollard et al. are about the same as the outside dimensions of mounting bracket 100 of Darden et al. Since slide-in cartridge 40 of Darden et al. fits within mounting bracket 100, bracket 20 of Pollard et al. is physically too large to fit within slide-in cartridge 40 of Darden et al. in the manner suggested by the Examiner. One might argue with the benefit of hindsight that perhaps floppy drive 10 of Pollard et al. could be reduced in size from a standard 3½-inch form factor or mounting bracket 100 and slide-in cartridge 40 of Darden et al. could be enlarged beyond the standard 5½-inch drive form factor. However, the motivation for doing so is not of record in this case and such seems to be contrary to the teachings of Pollard et al. and Darden et al. to utilize standard form factor bays available in numerous computer systems. Applicant finds no guidance in the cited art as to how these limitations would be overcome such that the various components cited by the Examiner can physically fit together.

Another way in which the combination is troubling is the lack of motivation to mount a reader for a removable medium in a removable carrier. The removability seems redundant and unnecessary, absent Applicant's disclosure. This point was made in the Response filed December

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23, 2002 and that discussion is incorporated herein by reference.

The Examiner has appeared to make too arguments with respect to this aspect. First, the Examiner stated that “[r]ails would aid guidance of the carrier,” providing a motivation to combine Darden et al. with the rest of the combination. Later, the Examiner asserted that the “claims do not define over card devices fixed by fasteners,” suggesting that the slidability of Darden et al. isn’t necessary for *prima facie* rejection of the claims. Taken together, the Examiner seems to assert that the ordinary artisan was motivated at the time of the invention to use rails with other fasteners such as screws.

With respect to the former assertion, Applicant believes it is helpful to consider bracket 20 of Pollard et al. as an example of why rails are generally not considered helpful by ordinary artisans at the time the invention was made. Within the standard 5½-inch drive bay slot 12 are slots through which mounting screws can be used to mount 5½-inch form factor disk drives and to mount bracket 20 (Darden et al. at column 3, lines 34-35). Slots, rather than holes, are provided for such mounting screws to compensate for variances from strict alignment of screw placement in various drives. Long before filing of the instant patent application, and perhaps as much as a decade prior to filing, a clear preference for slots over holes for mounting screws shows a clear preference for flexibility in the manner of mounting devices within a computer. The use of rails in a mounting bracket is contrary to this clear preference for flexibility.

Thus, Applicants respectfully submit that the Examiner’s motivation of guidance of the carrier is contrary to the actual motivation in mounting mechanisms at the time the invention was made.

Applicant also respectfully submits that the Examiner’s latter assertion that mounting by

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fasteners reads on the claims is incorrect. Claim 1 recites that the carrier is "slidably and removably mountable in the docking assembly." While it is true that devices can be removed by removing screws and other fasteners, this is not what is commonly understood in the art of computer peripherals by the term "removable." Claims 15 and 17 similarly recite that the carrier has "rails that slide with respect to the rails of the rack to enable the carrier to slide into the rack and to removably mount the carrier in the rack."

Thus, Applicant respectfully submits that mounting with fasteners is not "removable" as understood by those skilled in the art.

Accordingly, because of the physical dimensions and teachings of utilizing standard form factors, because of the clear preference for mounting flexibility, and because of the difference between fastener mounting and removably mounting, the combination asserted by the Examiner is not properly combined for analysis under Section 103. The claims are therefore allowable over the cited art.

The Examiner also rejected Claims 15-18 based generally on Kaneda et al. and Harari et al. These rejections are also traversed and reconsideration and withdrawal of these rejections is respectfully requested.

Kaneda et al. neither teach nor suggest a "carrier" in that adapters 7, 7', and 7" provide connections for various cards but do not facilitate carrying. Harari et al. neither teach nor suggest receiving "plural cards" as recited by Claims 15-18. Accordingly, Claims 15-18 are allowable over these additionally cited references.

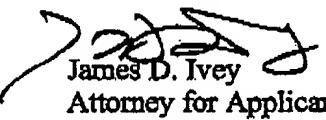
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CONCLUSION

Claims 1, 3-11, and 13-18 are now in a condition for allowance and such action is respectfully requested. If the Examiner's next action is other than for allowance of Claims 1, 3-11, and 13-18, or if the Examiner has any questions or comments with respect to the above-identified case, the Examiner is respectfully invited to telephone the undersigned at (510) 336-1100.

Respectfully submitted,



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1. Response to Office Action with certification of mailing by First Class Mail (12 pages);
2. PTO/SB/21 - Transmittal Form (1 page);
3. PTO/SB/22 - Petition for Extension of Time (1 page);
4. PTO/SB/17 - Fee Transmittal Form (1 page);
5. Check for \$475 in 3-month extension fees.

JDI
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